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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,764	08/05/2003	Kouji Arai	16869P-006210US	1709

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EXAMINER

COBY, FRANTZ

ART UNIT PAPER NUMBER

2171

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,764

Applicant(s)

ARAI ET AL.

Examiner

Frantz Coby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08-05-03</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2171

This is in response to application filed on August 05, 2003 in which claims 1-25 were canceled and claims 26-58 were added.

Status of Claims

Claims 26-58 are pending.

Information Disclosure Statement

The information disclosure statement filed on August 05, 2003 is in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file and the information referred to therein has been considered as to the merits.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 26-58 are rejected under the judicially created doctrine of double patenting over claims 1-37 of U. S. Patent No. 6,643,667 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: receiving a query for properties to identify the content categories for which the selected search engine is suited; and receiving a query to locate content based on at least one content category of the identified content categories.

Claims 26-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent no. 6,643,667. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-11 of patent 6,643,667 contains every element of claims 26-36 of the instant application and as such anticipates claims 26-36 of the instant application.

Claim 37 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 12 of U.S. Patent no. 6,643,667. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 12 of patent 6,643,667 contains every element of claim 37 of the instant application and as such anticipates claim 37 of the instant application.

Claim 38 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent no. 6,643,667. Although the conflicting claims are not identical, they are not patentably distinct from each other because

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claim 13 of patent 6,643,667 contains every element of claim 38 of the instant application and as such anticipates claim 38 of the instant application.

Claims 39-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-19 of U.S. Patent no. 6,643,667. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14-19 of patent 6,643,667 contains every element of claims 39-46 of the instant application and as such anticipates claims 39-46 of the instant application.

Claim 47 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 20 of U.S. Patent no. 6,643,667. Although the conflicting claim is not identical, it is not patentably distinct from each other because claim 20 of patent 6,643,667 contains every element of claim 47 of the instant application and as such anticipates claim 47 of the instant application.

Claims 48-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-22 of U.S. Patent no. 6,643,667. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 21-22 of patent 6,643,667 contains every element of claims 48-49 of the instant application and as such anticipates claims 48-49 of the instant application.

Claim 50 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent no. 6,643,667. Although the conflicting claim is not identical, it is not patentably distinct from each other because claim 23 of patent 6,643,667 contains every element of claim 50 of the instant application and as such anticipates claim 50 of the instant application.

Claims 51-55 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 24-34 of U.S. Patent no. 6,643,667. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 24-34 of patent 6,643,667 contains every element of claims 51-55 of the instant application and as such anticipates claims 51-55 of the instant application.

Claims 56-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 35-37 of U.S. Patent no. 6,643,667. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 35-37 of patent 6,643,667 contains every element of claims 56-58 of the instant application and as such anticipates claims 56-58 of the instant application.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 571 272-4017. The examiner can normally be reached on Monday-Saturday between 3:00 P.M – 11:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703 308 1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Frantz Coby
Primary Examiner
Art Unit 2161

October 12, 2004